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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,600	04/09/2001	Steven E. Barile	42390P9913	7945

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EXAMINER

ALAUBAIDI, HAYTHIM J

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,600

Applicant(s)

BARILE ET AL.

Examiner

Haythim J. Alaubaidi

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 29-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 29-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to the amendment filed on November 17, 2003.
2. The Examiner acknowledges the cancellation of Claims 21-28.
3. The Examiner acknowledges the newly added Claims 29-35.
4. Claims 1-20 and 29-35 are currently presented for examination following the amendment.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 8, 15 and 29, are rejected under 35 U.S.C. 102(e) as being anticipated by Christopher Dengler (U.S. Patent No. 6,581,103 and Dengler hereinafter).

Regarding Claims 1, 8, 15 and 29, Dengler discloses:

receiving a dedication¹ from a first user via a network for playback by at least one of a browser and a media player application on a processing system (Col 2, Lines

¹ The "dedication" is being interpreted as the "request" in Dengler's reference.

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36-38; see also Col 2, Lines 50-55; see also Col 4, Lines 35-38) operated by a second user (Col 2, Lines 54-55; see also Fig 1, Element 10; see also Col 3, Lines 37-40); and automatically applying the dedication to a play list (Col 3, Lines 14-24; see also Col 3, Line 66 through Col 4, Line 3; see also Col 4, Lines 24-25) of the second user without interaction by the second user (Col 2, Lines 54-55; see also Fig 1, Element 10; see also Col 3, Lines 37-40; see also Col 2, Lines 44-47; and also Col 3, Lines 4).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 8, 15 and 29, are rejected under 35 U.S.C. 103(a) as being unpatentable over Christopher Dengler (U.S. Patent No. 6,581,103 and Dengler hereinafter).

Regarding Claims 1, 8, 15 and 29, Dengler discloses:

receiving a dedication² from a first user via a network for playback by at least one of a browser and a media player application on a processing system (Col 2, Lines 36-38; see also Col 2, Lines 50-55; see also Col 4, Lines 35-38); and

applying the dedication to a play list (Col 3, Lines 14-24; see also Col 3, Line 66 through Col 4, Line 3; see also Col 4, Lines 24-25).

Dengler reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate a second user nor does it explicitly addresses the automation step of the second limitation. However, Dengler teaches a radio Internet broadcast which is acting just like the second user because the requests (dedications) are being received by this radio Internet broadcast (Col 2, Lines 54-55; see also Fig 1, Element 10; see also Col 3, Lines 37-40) also the reference teaches a live disc jockey (Col 3, Lines 4) who is reading the ~~reading~~ dedications (also known as "messages" in the current application), the reference also teaches sending an e-mail with the associated dedication to the destination user (Col 3, Lines 9-10).

Given the intended broad application of Dengler's system, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Dengler by interpreting the radio Internet broadcast to be the second user. In Dengler's system, two entities are present; entity one is the user (also referred to as the "listener" who is requesting the song or the video to send or dedicate it to the second entity; and entity two is the receiving part which can be a user or a computer (Col 2, Lines 44-47) or a live disc jockey (Col 3, Lines 4). The Examiner would like direct the Applicant's attention to the fact that modifying Dengler's system by substituting the second entity, such as, the Radio Internet Broadcast with a second user would be obvious for many reasons, one reason would be to personalize the system by allowing only the receiving user (second entity) to listen to the dedication on his/her computer instead of having the entire user community (everyone who is logged on at

² The "dedication" is being interpreted as the "request" in Dengler's reference.

the time of the dedication, {Col 2, Lines 44-47}) to listen to the dedication, other reasons, such as to increase the privacy of the information being broadcast³.

Dengler reference is also silent towards the automation process of applying the dedication with no user interaction. However the reference does teach a network that is being used to transmit the requests (Col 2, Line 44, i.e. Internet), the reference also teaches a computer application that displays a search screen (Fig 2), a search result screen (Fig 3) and a "submit" button (Fig 3, Element 32).

Given the intended broad application of Dengler's system, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Dengler to include this automation process as its understood in the computer programming that a "submit" button in an application would normally send information (request) from one location to another (receiving entity), which can be found in Dengler's system by the indication of the "request Queue" (Col 4, Lines 24-25) which is an indication to the fact that a request was sent to this queue, and since the communication between the entities are through the Internet, then it would have been obvious that this addition to the queue is automatic.

³ The Examiner would like to direct the Applicant's attention to the well known radio broadcast and dedication method and system presented by **Casey Kasem** as he is one of the most listened-to and well recognized DJ's in the world. He hosts *America's Weekly Top 40* and *Top 20*, since the 1970's and is heard on more than 450 radio stations worldwide. Kasem is also the host of the daily feature *America Top Hits* (www.logic.org). All the limitations of Claim 1 and the other Independent claims would read on Casey Kasem's broadcast show especially when counting him as the second user who is receiving the requests and dedications, the radio would be the "media player", the telephone switch network that the users use would be the "network", and the dedication song list he reads would be the "play list".

Regarding Claims 2, 9, 16 and 30 Dengler discloses receiving a message⁴ and applying the message to a play list (Col 1, Lines 59-64; see also Col 2, Line 61 through Col 3, Line 10).

Dengler reference is silent towards the insertion point⁵. However the reference does teach when a request (dedication) will be played and how it effect the sequence of the play list. If there is a request and if there is no request (Col 3, Lines 14-24), the reference also teaches a notification to the requester regarding if any requests are ahead, and if there are then how many requests are ahead of it (Col 3, Line 66 through Col 4, Line 3).

Given the intended broad application of Dengler's system, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Dengler by allowing the requester to indicate an insertion point for the dedication in the listeners play list, a good reason to modify the reference would be to increase the flexibility of the system, thus by allowing the requester to decide the insertion point instead of having the system to decide (Col 3, Lines 14-24; see also Col 3, Line 66 through Col 4, Line 3), increasing the flexibility would also lead to increase in the amount of users who would like to use, own or purchase the system, for example, a user would like to hear his/her request played at a certain time because he/she knows what time the other user (listener) would be available to listen to the request.

⁴ The Examiner is interpreting the "message" in the current application to be the same as the "dedication" in Dengler's reference.

⁵ The "insertion point" is being interpreted as the position of the song or file in the play list of the other user (listener) (see the "amendment to the specification", page 2 of the amendment filed Jun 16, 2003.

Regarding Claims 3-4, 10-11, 17-18 and 31-32 Dengler discloses audio and/or video (Col 1, Lines 52-59).

Regarding Claims 5-6, 12, 14, 19-20, 33 and 35 Dengler discloses text in the message and converting this text to audio (Col 2, Lines 61-63).

Regarding Claim 7 Dengler discloses wherein the first and second users are online (Col 2, Lines 44-47).

Regarding Claims 13 and 34, Dengler reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate the step of receiving an indication of whether the second user is online or not. It is well known in the art in general and specifically in the so called chat rooms that a first user will see or get an indication that a second user is online, in order for the first user to send a text, audio or even video file to the second user. Given the intended broad application of Dengler's system and the well known feature of chatting and interactive communication, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Dengler with the well known feature mentioned above to include It in the Applicant's invention in order to minimize the system resources by not sending or receiving any requests if the second user is not online⁶.

Other Prior Art Made of Record

9. Gold et al. (U.S. Patent Publication Application No. 2002/0032752) discloses a method and system for electronic song dedication.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Points of Contact

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haythim J. Alaubaidi whose telephone number is (703) 305-1950. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any response to this office action should be mailed to:

The Commissioner of Patents and Trademarks, Washington, D.C. 20231 or telefax at our fax number (703) 872-9306.

Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6th Floor Receptionist, Arlington, Virginia. 22202.

Haythim J. Alaubaidi

Patent Examiner
Technology Center 2100
December 8, 2003


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

⁶ In regard to the chat rooms, please see (Morris et al, Patent No. 6,496,851).